

04-30-01

A

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. ORCH 0162 PUS

Anticipated Classification of this application

Class \_\_\_\_\_ Subclass \_\_\_\_\_

Prior application:

Examiner: \_\_\_\_\_

Art Unit: \_\_\_\_\_

Assistant Commissioner  
for Patents  
Box Patent Application  
Washington, D.C. 20231

## FILING UNDER 37 CFR 1.53(b)

WARNING: A c-i-p (continuation-in-part) cannot be filed under 37 CFR 1.53.

WARNING: Filing under 37 CFR 1.53 is permitted only if filed by the same or less than all the inventors named in the prior application.

WARNING: The filing of an application as the United States stage of an International Application requires an oath or declaration. 37 CFR 1.51(a)(4).

WARNING: The claims of this new application may be finally rejected in the first Office action where all claims of the new application are drawn to the same invention claimed in the earlier application and would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. MPEP '706.07(b).

This request for filing a

  X   Continuation            Divisionalapplication under 37 CFR 1.53, of pending prior application serial no. 09/321,170 filed on05/27/99 of Robert D. Juncosa, et al.

(inventor(s))

for Genetic Assay System  
(title of invention)

## CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this 37 CFR 1.53 request and the documents referred to as attached therein are being deposited with the United States Postal Service on this date April 27, 2001 in an envelope as "Express Mail Post office to Addressee" service under 37 CFR 1.10, Mailing Label Number EL 819994946 US addressed to the: Assistant Commissioner for Patents, Box Patent Application, Washington, D.C. 20231.

Kevin G. Mierzw

(Type or print name of person mailing paper)

(Signature of person mailing paper)

NOTE: Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. (37 CFR 1.10(b)).

(37 CFR 1.53B page 1 of 8)

04/27/01  
JC964 U.S. PTO

10/27/01  
09/844980  
31000 U.S. PTO

09/844980-312701

NOTE: 37 CFR 1.53 permits the omission of a declaration only if the prior application was complete as set forth in 37 CFR 1.51(a), namely, the prior application comprised at least (1) a specification, including a claim or claims; (2) a declaration; (3) drawings when necessary; and (4) the prescribed filing fee. Accordingly, as presently worded, 37 CFR 1.53 does not permit this procedure to be used where the prior application is pending but only the processing and retention fee required by 37 CFR 1.21(1) is paid or where the declaration was not filed.

1. Copy of Prior Application as Filed Which is Attached

NOTE: Under 37 CFR 1.53 practice signing and execution of the application by the applicant may be omitted provided the copy is supplied by and accompanied by a statement by the applicant or his or her attorney or agent that the application papers comprise a true copy of the prior application as filed and that no amendments referred to in the declaration filed to complete the prior application introduced new matter therein.

NOTE: This statement need not be verified if made by an attorney registered to practice before the PTO. (37 CFR 1.53(b)).

  X   I hereby verify that the attached papers are a true copy of what is shown in my records to be the above identified prior application, including the oath or declaration originally filed (37 CFR 1.53).

The copy of the papers of prior application as filed which are attached are as follows:

  26   page(s) of specification

      3   page(s) of claims

      1   page(s) of abstract

      11   page(s) of drawing  
(Also complete part 4 below if drawings are to be transferred)

       pages of declaration and power of attorney

If the copy of the declaration being filed does not show applicant's signature, indicate thereon that it was signed and complete the following:

       in accordance with the indication required by 37 CFR 53(b) my records reflect that the original signed declaration showing applicant's signature was filed on                     .

       the amendment referred to in the declaration filed to complete the prior application and I hereby state, in accordance with the requirements of 37 CFR 1.53(b), that this amendment did not introduce new matter therein.

2. Amendments

WARNING: "The claim of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all the claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application." MPEP '704.07(b).

       Cancel in this application original claims                      of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)

  X   A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

NOTE: Only amendments reducing the number of claims or adding a reference to the prior application (Rule 1.78(a)) will be entered before calculating the filing fee and granting the filing date. 37 CFR 1.53(b).

NOTE: "When filing under Rule 1.53 retain at least one original claim from the patent application to assure a complete application." Notice of March 3, 1986 (ID44 O.G. 37-38).

3. Petition for Suspension of Prosecution for the Time Necessary to File an Amendment

NOTE: Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary).

(check the next item, if applicable)

\_\_\_\_\_ There is provided herewith a Petition To Suspend Prosecution For The Time Necessary to File An Amendment (New Application Filed Concurrently).

4. Fee Calculation (37 CFR 1.16)

	No. Filed	No. Extra	Small Entity Fee	Large Entity Fee
Basic Fee			\$355	\$710.00
Total Claims	15 -20	0	x9 =	x18 =
Indep. Claims	4 -3	1	x40 =	x80 = \$ 80.00
Multiple Dependent Claims			+135 =	+270 =
			TOTAL	TOTAL \$790.00

\_\_\_\_\_ Fee for extra claims is not being paid at this time. (37 CFR 1.16(d))

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the PT0 in any notice of fee deficiency, 37 CFR 1.16(d).

Filing Fee Calculation \*790.00

5. Small Entity Status

\_\_\_\_\_ A verified statement that this filing is by a small entity:

\_\_\_\_\_ is attached

\_\_\_\_\_ has been filed in the parent application and such status is still proper and desired (37 CFR 1.26(a))

Filing Fee Calculation (50% of above) \*\_\_\_\_\_

NOTE: Any excess of the full fee paid will be refunded if a verified statement is filed within 2 months of the date of timely payment of a full fee then the excess fee paid will be refunded on request. 37 CFR 1.26(a).

NOTE: 37 CFR 1.26(a), last sentence states: "Applications filed under '1.53 of this part must include a reference to a verified statement in a parent application if status as a small entity is still proper and desired."

6. Drawings

WARNING: Do not check the following box if prior case is not to be abandoned.

\_\_\_\_\_ Transfer the drawings from the prior application to this application and, subject to item 17 below, abandon said prior application as of the filing date accorded this application. A duplicate copy of this request is enclosed for filing in the prior application file. (May only be used if signed by (1) applicant, (2) assignee of record or (3) attorney or agent of record authorized by 37 CFR 1.136 and before payment of issue fee).

(37 CFR 1.53B page 3 of 8)

NOTE: "A registered attorney or agent acting under the provisions of '1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application." 37 CFR 1.136.

\_\_\_\_\_ Transfer the following sheet(s) of drawing from the prior application to this application \_\_\_\_\_.

NOTE: Transferred sheets must be cancelled in prior application. 37 CFR 1.88.

\_\_\_\_\_ A copy of the amendment cancelling these sheets of drawing in the prior application is attached.

☒ New drawings are enclosed:

\_\_\_\_\_ ☒ formal

\_\_\_\_\_ informal

WARNING: DO NOT submit original drawings. A high quality copy of drawings should be supplied when filing a patent application. The drawings that are submitted to the Office must be on strong, white, smooth, and non-shiny paper and meet the standards of '1.84. If corrections to the drawings are necessary, they should be made to the original drawings and a high-quality copy of the corrected original drawing then submitted to the Office. Only one copy is required or desired. Comments on proposed new 37 CFR 1.84. Notice of March 9, 1988 (1090 O.G. 57-42).

NOTE: "Identifying indicia such as the serial number, group art unit, title of the inventor, attorney's docket number, inventor's name, number of sheets, etc. not to exceed 2-3/4 inches (7.0 cm.) in width may be placed in a centered location between the side edges within three-fourths inch (19.1 mm.) of the top edge. Either this marking technique on the front of the drawing or the placement, although not preferred, of this information and the title of the invention on the back of the drawings is acceptable." Proposed 37 CFR 1.84(1). Notice of March 9, 1988 (1090 O.G. 57-42).

7. Priority - 35 U.S.C. 119

\_\_\_\_\_ Priority of application serial no. 0 / \_\_\_\_\_ filed on \_\_\_\_\_  
\_\_\_\_\_ in \_\_\_\_\_ is claimed under 35 U.S.C. 119.  
(country)

\_\_\_\_\_ The certified copy has been filed in prior U.S. application serial no. 0 /  
on \_\_\_\_\_.

\_\_\_\_\_ The certified copy will follow.

8. Relate Back - 35 U.S.C. 120

☒ The enclosed Preliminary Amendment awards the specification to relate back to the parent case.

NOTE: The proper reference to a prior filed PCT application which entered the U.S. national phase is the

[illegible]

Total fees enclosed \$ 790.00

12. Method of Payment of Fees

☒ enclosed is a check in the amount of \$ 750.00

☐ charge Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_. A duplicate of this request is attached.

NOTE: Fees should be itemized in such a manner that is clear for which purpose the fees are paid. 37 CFR 1.22(b).

13. Authorization To Charge Additional Fees

WARNING: If no fees are being paid on filing do not complete this item.

WARNING: Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges if extra claim charges are authorized.

☒ The Commissioner is hereby authorized to charge the following additional fees which may be required by this paper and during the entire pendency of the application to Account No. 50-0476.

☒ 37 CFR 1.16(a), (f) or (g) (filing fees)

☒ 37 CFR 1.16(b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PT0 in any notice of fee deficiency (37 CFR 1.16(d)) it might be best not to authorize the PT0 to charge additional claim fees, except possibly when dealing with amendments after final action.

☐ 37 CFR 1.17 (application processing fees)

WARNING: While 37 CFR 1.17(a), (b), (c) and (d) deal with extensions of time under 1.13b(a) this authorization should be made only with the knowledge that: "Submission of the appropriate extension fee under 37 CFR 1.13b(a) is to no avail unless a request or petition for extension is filed." [emphasis added]. Notice of November 5, 1985 (1060 E.G. 27).

☐ 37 CFR 1.18 (issue fee at or before mailing Notice of Allowance, pursuant to 37 CFR 1.311(b)).

NOTE: Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the Notice of Allowance. 37 CFR 1.311(b)).

NOTE: 37 CFR 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application. . . prior to paying or at the time of paying. . . issue fee." From the wording of 37 CFR 1.28(b): (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

14. Power of Attorney

☒ The power of attorney in the prior application is to

Kevin G. Mierzwa  
Attorney

38-047  
Reg. No.

a. ☒ The power appears in the original papers in the prior application.

b. ☐ Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.

c.        A new power has been executed and is attached.

d.   X   Address all future communications to:

Kevin G. Mierzwa, Esq.  
Artz & Artz, P.C.  
28333 Telegraph Road, Suite 250  
Southfield, MI 48034

(Item d may only be completed by applicant, or attorney or agent of record)

15. Maintenance of Copendency of Prior Application

(This item must be completed and the papers filed in the prior application if the period set in the prior application has run)

       A petition, fee and response has been filed to extend the term in the pending prior application until \_\_\_\_\_

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the Continuation Application. Notice of November 5, 1985 (1060 0.6. 27).

       A copy of the petition for extension of time in the prior application is attached

16. Conditional Petition for Extension of Time in Prior Application

(complete this item and file conditional petition in the prior application if previous item not applicable)

       a conditional petition for extension of time is being filed in the pending parent application.

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the paper constituting the filing of the continuation application. Notice of November 5, 1985 (1060 0.6. 27).

       A copy of the conditional petition for extension of time in the prior application is attached.

17. Abandonment of Prior Application (if applicable)


WARNING: (Do not complete this item if the application being filed is a divisional of the prior application which is not being abandoned)

NOTE: "A registered attorney or agent acting under the provisions of '1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application." 37 CFR 1.138.

       Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application copending with said prior application.

I hereby declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 3001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

4/27/01  
Date

Kevin G. Nierzwa  
Type or print name of person signing  
  
Signature

P.O. Address of Signatory

26333 Telegraph Road  
Suite 250  
Southfield, Michigan 48034

Tel. No.: (248) 223-7500

on behalf of

Reg. No. 36,049  
(if applicable)

\_\_\_\_ Inventor

\_\_\_\_ Assignee of complete interest

\_\_\_\_ Person authorized to sign  
assignee

☒ Attorney or agent of record

\_\_\_\_ Filed under Rule 34(a)

(complete the following if applicable)

Orchid BioSciences, Inc.  
Type name of assignee

Address of assignee  
303 College Road East  
Princeton, New Jersey 08540

\_\_\_\_  
Title of person authorized to sign on  
behalf of assignee

Assignment recorded in PTO on \_\_\_\_\_

Reel \_\_\_\_\_ Frame \_\_\_\_\_